

Remarks:

Claims 1–11 are pending in the present application with claims 1, 6, and 11 being independent. In the Office Action dated October 18, 2005 (“OA”), claims 1, 6, and 11 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement and the enablement requirement. Claims 1–3 and 6–8 were rejected under 35 U.S.C. § 102(b) as being anticipated by Zhou, U.S. Patent Application Publication No. 2002/0005574. Furthermore, claims 4, 5, and 9–11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zhou in view of Stark, U.S. Patent No. 6,759,590, and Leung, U.S. Patent No. 6,661,090. Applicant traverses all claim rejections for at least the reasons set forth below.

The rejections based on 35 U.S.C. § 112, first paragraph

The rejection of claims 1, 6, and 11 for failing to comply with the written description requirement § 112

Regarding the rejection of claims 1, 6, and 11 under § 112, first paragraph, for failing to comply with the written description requirement, it was asserted in the Office Action that “there is no description in the specification where the walls and the top each being made of a continuous piece of material,” but rather that “the specification (see pp. 3, lines 24–34) describes the walls and top being made of a single piece structure.” (OA, page 2). Applicant respectfully disagrees. While the claim language cited in the Office Action is not expressly recited in the specification, the written description requirement of § 112 is clearly satisfied by the specification in, for example, figures 2 and 3; page 3, lines 24–34; and claims 1, 6, and 11 (as originally filed).

Applicant initially notes that the drawings may be relied upon to satisfy the written description requirement of § 112. The Federal Circuit has clearly stated, for example, that support for a claimed feature may come from the drawings. *Vas-Cath Incorporated v. Mahurkar*, 935 F.2d 1555, 1565-67 (Fed. Cir. 1991). The Court in *Vas-*

Cath cited *In re Wolfen-Sperger*, 302 F.2d 950, 955-57 (CCPA 1962) and *In re Heinle*, 342 F.2d 1001 (CCPA 1965) as support for its holding that “under proper circumstances, drawings alone may provide a ‘written description’ of an invention as required by § 112.” It was explained by the Federal Circuit in *In re Hunter*, 59 F.3d 181, 183 (Fed. Cir. 1995) that the written description may be satisfied by various parts of the disclosure, including the drawings, tables, equations, and formulas, alone or in combination. Drawings alone constitute an adequate description if they describe what is claimed and convey to those skilled in the art that the patentee actually invented what is claimed. *Vas-Cath*, 935 F.2d at 1566.

The Court in *Vas-Cath* said the issue in *In re Wolfen-Sperger*, was whether the application drawings supported a claim limitation that read: “having, in untensioned condition, a mean diameter corresponding approximately to the mean diameter of said chamber and a radial width smaller than the radial width of said chamber” *Id.* 302 F.d at 952.

The board’s statement that “drawings alone cannot form the basis of a valid claim” is too broad a generalization to be valid and is, furthermore, contrary to well-settled and long-established Patent Office practice Consider, for one thing, that the sole disclosure in a design patent application is by means of a drawing For another thing, consider that the only informative and significant disclosure in many electrical and chemical patents is by means of circuit diagrams or graphic formulae, constituting “drawings” in the case The practical, legitimate enquiry in each case of this kind is what the drawing in fact discloses to one skilled in the art .

. . . .
. . . . The issue here is whether there is supporting “disclosure” and it does not seem, under established procedure of long standing, approved by this court, to be of any legal significance whether the disclosure is found in the specification or in the drawings so long as it is there.

Id. 302 F.2d at 955-56.

In re Heinle concerned a new matter rejection where the CCPA reversed a U.S. PTO rejection of the application’s claims to a “toilet paper core” as “including subject

matter having no clear basis in the specification as filed.” *Heinle*, 342 F.2d at 1003. The claim limitation, which the examiner said was without support, required the width of apertures in the core to be “approximately one-fourth of the circumference of said core.” *Heinle*, 342 F.2d at 1007. Based upon a review of the application drawings relied upon for support, the CCPA said:

it seems to us that [the drawings] conform to the one-fourth circumference limitation almost exactly. But the claim requires only an approximation. Since we believe an amendment to the specification to state that one-fourth of the circumference is the aperture width would not violate the rule against “new matter,” we feel that supporting disclosure exists. The rejection is therefore in error.

Id. 342 F.2d at 1007.

The CCPA in *In re Heinle* reasoned that because the drawings and specifications may be amended to conform to each other and that amending the description to conform to the drawings is not new matter, relying upon drawings for claimed relationship of parts would not violate the rule against “new matter.” Accordingly, the court in *In re Heinle* found that the supporting disclosure for the claimed relationship of the parts was found in the drawings, even though the relationship was not explicitly set forth in the description. *Heinle*, 342 F.2d at 1007.

The Federal Circuit, citing *Vas-Cath* in *Cooper Cameron Corp. v. Kvaerner Oilfield Products, Inc.*, 291 F.3d 1317, 1322 (Fed. Cir. 2002), said that “drawings constitute an adequate description if they describe what is claimed and conveyed to those skilled in the art that the patentee actually invented what is claimed” As in *Vas-Cath*, the invention claimed in *Cooper* was the invention shown in the drawing. *Cooper*, 291 F.3d at 322.

The attitude of the Board of Appeals on this issue was set forth in footnote 3 of *Ex Parte Lejambre, et al.*, 2002 WL 1801305, wherein the Board, citing cases including *Vas-Cath*, stated that “while of course drawings are not drawn to scale, they may nevertheless be used to establish relationships or proportions between the various

components which are clearly depicted therein.”

Accordingly, there is ample legal support for the use of the disclosure of the drawings in this application for the claiming of the walls and the top of the cover as each being made of a continuous piece of material.

Turning now to the drawings themselves, figure 2 illustrates the “single piece cover” (28) recited in claim 1, including walls (29) and top (30). The walls and the top, which were originally expressly disclosed in the specification, are clearly shown in figure 2 as each being made of a continuous piece of material. The dictionary defines “continuous” as “characterized by uninterrupted extension in space.” WEBSTER’S THIRD NEW INTERNATIONAL DICTIONARY 493–94 (2002). The walls and the top are clearly each made of a piece of material that is characterized by uninterrupted extension in space because, for example, the walls and top are each illustrated as smooth, seamless elements with no holes, slots or discontinuities of any kind. This is also supported by the disclosure that the cover “seals to the substrate underlying the microsystem to create a hermetic cavity . . .” (Application, page 3, lines 25–26). An aperture in the cover would prevent the cover from creating a hermetic cavity.

Page 3, lines 24–34 of the specification and claims 1, 6, and 11 (as originally filed) provide further support for the claim language at issue. Page 3, lines 24–25 recite, for example, that the enclosure includes a “single-piece hermetic cover structure,” and claims 1, 6, and 11 recite a “single piece cover.” Because the cover is described as a “single piece,” it follows that each portion of the cover (i.e., each wall and the top) also comprise a “single piece.” As set forth above, the specification explains that the cover creates a hermetic cavity, and therefore the walls and top are inherently free of holes or other apertures. Therefore, because the walls and top are illustrated in figure 2 as uninterrupted portions of the cover, are described in the specification as part of a “single piece” cover, and form a hermetic cavity when the cover is soldered to the substrate, a person of ordinary skill in the art would clearly recognize from the specification as filed that Applicant was in possession of the invention as currently recited in claims 1, 6, and 11.

The rejection of claims 1, 6, and 11 for failing to comply with the enablement requirement of § 112

Regarding the rejection of claims 1, 6, and 11 under 35 U.S.C. § 112, first paragraph, for failing to comply with the enablement requirement, it was asserted in the Office Action that “there is no description in the specification how the walls and the top each are being made of a continuous piece of material,” but rather that “the specification (see pp. 3, lines 24–34) describes the walls and top being made of a single piece structure.” (OA, page 2). Applicant respectfully disagrees. While the claim language cited by the Examiner is not expressly recited in the specification, the enablement requirement of § 112 is clearly satisfied by the specification in, for example, figures 2 and 3; page 3, lines 24–34; and claims 1, 6, and 11 (as originally filed).

The test of enablement is whether “one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” *U.S. v. Teletronics, Inc.*, 857 F.2d 778 (Fed. Cir. 1988); MPEP 2164.01. The specification discloses many details of the cover, including, for example, that it is nickel and gold plated with a minimum of approximately 0.000075 inches of gold over a minimum of approximately 0.000050 inches of nickel. As explained in the previous section, a person of ordinary skill in the art would clearly recognize from the specification as filed that the invention includes a cover with walls and a top that are “each made of a continuous piece of material.”

Thus, using these and other details of the cover disclosed in the application coupled with information known in the art, a skilled artisan could make the invention with little or no experimentation, and certainly without “undue” experimentation.

The rejections based on 35 U.S.C. §§ 102 and 103

Regarding the rejection of claims 1–3 and 6–8 under § 102(b), Applicant asserts that the Office Action failed to cite a reference that anticipates these claims. A “claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987); MPEP § 2131. Furthermore, the “identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226 (Fed. Cir. 1989); MPEP § 2131.

Zhou fails to teach, either expressly or inherently, each and every element as set forth in claims 1–3 and 6–8. Zhou, for example, fails to teach “a single-piece cover having walls and a top, *wherein the walls and the top are each made of a continuous piece of material*,” as recited in claims 1 and 6. Rather, Zhou discloses a cover with a connection slot (404) in a wall thereof and a sealant slot (402) in a top thereof. The walls and top of Zhou, therefore, are clearly not each made of a continuous piece of material.

Furthermore, Zhou does not render the invention of claim 1 obvious because Zhou expressly teaches away from a cover with walls and a top “wherein the walls and the top are each made of a continuous piece of material.” The express purpose of Zhou, for example, is to provide a hermetically-sealed opto-electronic package that allows optical fibers to pass through walls of the package. (See, e.g., Zhou, ¶¶ 7–9, 51; FIG. 5). Therefore, modifying Zhou to include a cover with continuous walls and top as recited in claims 1 and 6 would render Zhou unsatisfactory for its intended purpose.

Thus, the Office Action failed to cite a reference that includes, either expressly or inherently, a cover “wherein the walls and the top are each made of a continuous piece of material” as recited in claims 1 and 6. Claims 2–3 and 7–8 depend from claims 1 and 6, respectively.

Regarding the rejection of claims 4, 5, and 9–11 under 35 U.S.C. § 103(a), the Office Action failed to establish the requisite *prima facie* case of obviousness by failing

to cite a reference or combination of references that teach or suggest all of the limitations of these claims. For example, the references do not teach or suggest a "single-piece cover having walls and a top, wherein the walls and the top are each made of a continuous piece of material" as recited in claims 1, 6, and 11 for reasons set forth previously.

Conclusion

For at least the reasons set forth above, applicant respectfully submits that claims 1, 6, and 11 are now in allowable condition and requests a Notice of Allowance. In the event of further questions, the Examiner is urged to call the undersigned. Any additional fee which is due in connection with this amendment should be applied against our Deposit Account No. 19-0522.

Respectfully submitted,
HOVEY WILLIAMS LLP

BY: 

Thomas B. Luebbering, Reg. No. 37,874
2405 Grand Blvd., Suite 400
Kansas City, Missouri 64108
(816) 474-9050

ATTORNEYS FOR APPLICANT(S)